

REMARKS

Upon entry of this amendment, claims 1-4 are all the claims pending in the application. Claims 5-16 are canceled by this amendment.

I. Claim Rejections under 35 U.S.C. § 103(a)

A. Claims 1 and 4 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Monsees (U.S. Patent No. 5,743,374) in view of Fujishiro et al. (U.S. Patent No. 3,595,370). Applicant respectfully traverses this rejection on the following basis.

Regarding claim 1, the Examiner recognizes that Monsees does not teach the feature of means for turning stacked sheets in a plane thereof. Nonetheless, the Examiner asserts that one of ordinary skill in the art would have been motivated to combine Monsees with the teaching of Fujishiro to arrive at the claimed invention.

Fujishiro discloses an apparatus which has the ability to turn stacked sheets by rotating a turntable (see col. 2, lines 41-43). Based on this teaching, the Examiner asserts that it would have been obvious to provide the turning mechanism of Fujishiro upon the stacking device of Monsees in order to provide a specific orientation so that markings on the workpiece such as instructions, logos, etc. are oriented properly for shipping/packaging. Applicant respectfully disagrees.

Contrary to the position set forth by the Examiner, Monsees makes absolutely no mention of any instructions, logos, etc. on the workpieces which would even remotely suggest to one of ordinary skill in the art that turning the workpieces of Monsees would be desirable. If the

Examiner is relying on personal knowledge as to the make-up of the workpieces disclosed by Monsees such that it would, in fact, be desirable to turn the workpieces, then Applicant respectfully requests that the Examiner provide support for such a position.

In formulating the grounds of rejection, the Examiner has done nothing more than to establish that a turning mechanism is a known apparatus. However, merely establishing that each element of a claimed combination was known in the prior art is not dispositive of patentability. Indeed, the Examiner has provided absolutely no evidence that would have led a person of ordinary skill in the art to provide the stacking apparatus of Monsees with the turning mechanism of Fujishiro.

By combining Monsees with Fujishiro, the Examiner is clearly employing impermissible hindsight in arriving at the claimed invention. Applicant submits that the Examiner has failed to establish a *prima facie* case of obviousness by providing a specific suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify Monsees as suggested by the Examiner.

As the Federal Circuit just recently reminded us, the USPTO is held to a *rigorous* standard when trying to show that an invention would have been obvious in view of the combination of two or more references. *See, In re Sang Su Lee*, 2002 U.S. App. LEXIS 855, *10 (Fed. Cir. 2002), *citing, e.g., In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) (“Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.”).

The Federal Circuit goes on to emphasize that the “need for specificity pervades this authority.” *In re Sang Su Lee* at *10-*11 (emphasis added) (citing *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) (“particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed”)).

Applicants respectfully submit that the current grounds of rejection do not satisfy the Federal Circuit’s *rigorous* standard for demonstrating that the claimed invention would have been obvious in view of the combination of the Monsees and Fujishiro. In other words, Applicant submits that the Examiner has not provided any evidence which would suggest to one of ordinary skill in the art that it would have been desirable to provide the stacking mechanism of Monsees with the turning mechanism disclosed by Fujishiro.

Even assuming, arguendo, that the combination of Monsees and Fujishiro is proper, Applicant submits that the combination fails to teach or suggest all of the features of claim 1. In particular, Applicant submits that the each limitation set forth in claim 1 must be interpreted under 35 U.S.C. § 112, sixth paragraph, as limited to the corresponding structure, material or acts described in the specification and equivalents thereof. *In re Donaldson.*, 16 F.3d 1189, 29 USPQ 2d 1845 (Fed. Cir. 1994) (“[T]he ‘broadest reasonable interpretation’ that an examiner may give means-plus-function language is that statutorily mandated in [section 112] paragraph six. Accordingly, the PTO may not disregard the structure disclosed in the specification corresponding to such language when rendering a patentability determination.”). See also MPEP 2181-2183.

Applicant respectfully submits that the combination of Monsees and Fujishiro fails to teach or suggest a mechanism that is similar in structure, materials, or function to that of the means for supplying, means for turning, means for vertically inverting, means for discharging, and means for transferring, when the specification of the present invention is properly considered.

If the Examiner persists in this rejection, Applicant respectfully requests that the Examiner particularly explain how the structure of the cited prior art is being interpreted such that the structure meets the limitations of claim 1 taking into account 35 U.S.C. § 112, sixth paragraph.

In view of at least the foregoing, Applicant respectfully submits that claim 1 is allowable over the applied art, and the Examiner is kindly requested to reconsider and allow the claims. Claim 4 depends from claim 1 and therefore incorporates all of the features thereof. Accordingly, Applicant submits that claim 4 is patentable at least by virtue of its dependency.

In addition, Applicant submits that the Examiner has failed to address the limitations within claim 4. Claim 4 specifically recites that the sheets comprise films produced by cutting a rolled photosensitive medium to predetermined lengths. It is clear that neither Monsees nor Fujishiro discloses such a feature. Accordingly, Applicant respectfully requests that the Examiner reconsider and withdraw the rejection.

To the extent that the Examiner has not afforded the limitations of claim 4 patentable weight, Applicant respectfully disagrees. Indeed, expressions relating an apparatus to contents thereof during an intended operation and inclusion of a material or article worked upon by a

claimed structure are not significant in determining patentability of the apparatus claim only to the extent that such recitations do not add **structural** limitations to the claim. However, to the extent that a claimed recitation adds a structural limitation, it is required of the examiner to give this recitation patentable weight.

Even if, for the sake of argument alone, the elements disclosed in Monsees correspond to the elements set forth in claim 1 as set forth by the Examiner, Applicant submits that the apparatus of Monsees is not capable of transferring films produced by cutting a rolled photosensitive medium. In Monsees, the stacking and transferring device operates on carton blanks. It is clear that the same stacking and transferring device disclosed by Monsees would not be utilized to transfer and stack a photosensitive medium, as set forth in claim 4. In contrast a carton blank, a photosensitive medium has a different size and must be handled in a more delicate fashion.

Thus, Applicant submits that the feature of sheets which comprise films produced by cutting a rolled photosensitive medium to predetermined lengths imparts a structural limitation to the claimed invention which cannot be ignored by the Examiner. Based on the foregoing, Applicant respectfully requests that the Examiner reconsider and withdraw the rejection.

Claim 3 is withdrawn from consideration as being drawn to a non-elected invention. However, as claim 3 depends from claim 1, Applicant respectfully requests that the claim be rejoined upon the allowance of claim 1.

Amendment Under 37 C.F.R. § 1.111
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B. Claim 2 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Monsees in view of Fujishiro et al. and further in view of Japanese Publication 1-210298 (hereafter JP '298). Claim 2 depends from claim 1 and therefore incorporates all of the features thereof. Accordingly, Applicant submits that claim 2 is patentable at least by virtue of its dependency.

II. Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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